



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,121	03/19/2001	Ichiro Hamada	SONY JP-121	3037

530 7590 11/17/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,121

Applicant(s)

HAMADA ET AL.

Examiner

Hai Tran

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 9-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/30/2006 has been entered.

Response to Arguments

Applicant's arguments filed 08/30/2006 have been fully considered but they are not persuasive.

In response to Applicant argument regarding the previous rejection of Claims 1, 3-8, 26-36 under 35 U.S.C. 112, first paragraph (see Applicant argument page 8-10), the Examiner respectfully disagrees with Applicant that the specification clearly describes to one skilled in the art that the purchase time limit is set based on the download time of the music piece content data.

It's noted that Fig. 4 is worth a thousand words, as applicant indicated; however Fig. 4 does not contain a thousand word to describe the features, as claimed and alleged by Applicant. Fig. 4 (Specification, p.26, ll. 14-22) clearly indicates the purchase limit time of the musical pieces A, B, and C are set at t1, t2 and t3, respectively (p.27, ll.8-10.) as the final time of the broadcasting of the music A, B, and C

Art Unit: 2623

(for example, duration of broadcasting of the music A for listener to listen the music A), but NOT the time it take to download the music!

The time to download a music A, B, and C is T_a , T_b and T_c respectively, as indicated by Fig. 4; T_a : time required to download music piece A once.

In view of that Broadcasting time of the music is the duration of broadcasting a music, i.e., music A, for listener to listen. For example broadcasting a song in which it takes 5 Min to finish the play so that listener could listen, is NOT the same as the time it take to download the music , for example time to download is 10 sec, in which the listener could not completely listen to the whole song/music, (with the duration of playback time is 5 min, that is currently broadcasted.

In view of that the Examiner maintains the rejection.

Applicant argument toward Lajoie is moot in view of the above pending claims under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-8, 26-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter,

Art Unit: 2623

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Various limitations “purchase limit time setting means for setting a purchase limit time that is based on the time it takes to download the content data”, “a purchase limit time substantially equal to the duration of the time it takes to download the content data”, “setting a purchase limit time that corresponds to the duration in time of one of the plurality of data segments for the music content data”, “wherein the purchase limit time comprises the time it takes to download the content data”, “in accordance with a purchase limit that defines a content data download time included in the program information”, “including a purchase limit time that corresponds to the time it takes to download the audio data”, “...including a purchase time limit that corresponds to the time for downloading one of the audio data packets” cited in independent claims 1, 4, 5, 6, 7, 8, 27, and 33 respectively, are not disclosed in the specification as indicated by Applicant at page 23, lines 20-23 and page 26, lines 12-22.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 5 define "a medium having computer-readable instructions for performing method for multiplexing downloadable musing content data together with program information onto **a broadcast signal ...**" embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

Moreover, a broadcast "**signal**" embodying functional descriptive material is neither a process ("actions"), machine, manufacture nor composition of matter (i.e., a tangible "thing") and therefore does not fall within one of the four statutory categories of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as **signals, carrier waves, etc** defined in the specification. Any amendment to the claim should be commensurate with its corresponding disclosure.

The examiner, for example, suggests amending the claim "**A medium having computer-readable instructions for performing a method of multiplexing**

downloadable music content data together with program information onto a broadcast signal" should be changed to the following:

-- A computer-readable medium encoded computer executable instructions, that when executed by the computer, cause the computer to perform a method for multiplexing downloadable music content data together with program information onto a transport stream for broadcasting --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

32 and 36

1. Claims 1, 3-8, 26-31, 33-35 are rejected under 35 U.S.C. 102(b) as being unpatentable by Lajoie et al. (US 5850218).

Claim 1, Lajoie discloses a broadcasting equipment for multiplexing downloadable contents data together with program information onto a main broadcast signal and broadcasting resultant data (Fig.1), characterized by comprising:

purchase limit time setting means for setting a purchase limit time that is based on the time it takes to download the contents data (reads on set time in which

user could buy a PPV program, i.e., "Buy until 8:15 PM; Fig. 28, el. 544; Col. 31, lines 1-32);

generating means for generating the program information including the purchase limit time (reads on display information that include time period in which user could purchase a PPV program; See Fig. 28, el. 544); and

multiplexing means for repeatedly multiplexing the same contents data and the program information a plurality of times onto the main broadcast signals of broadcasting time of one program, thereby generating a transport stream (reads on the display message of el. 544 is inherently cyclically transmitted to users such PPV information/service along with updating information within that period of time; Col. 10, lines 25-55).

Claim 3, Lajoie further discloses wherein the contents data includes audio data encoded by the ATRAC system or audio data encoded by the MPEG-2 system (Col. 10, lines 29-40 and Col. 14, lines 1-40).

Claims 4 and 5 are analyzed with respect to claim 1.

Claim 6, Lajoie discloses a receiving equipment for receiving a transport stream obtained by repeatedly multiplexing downloadable contents data together with program information onto a main broadcast signal a plurality of times (Fig. 3), comprising:

receiving means GUI with selected items, as shown on Fig. 28 and 30 for example in which the user use a RC to select)for receiving an instruction of downloading the contents data from a user;

capturing means (Fig. 3, el. 41,42) for capturing the contents from the transport stream in response to the download instruction received by the receiving means (reads on display PPV content on the screen to user; see Fig. 28; el. 562);

re-executing means for re-executing capture of when the capturing means fails to capture the content (see Fig. 30, el. 580, 584, 586; Col. 31, lines 55-Col. 32, lines 7) ;

the contents extracting means (Fig. 3, el. 37-38) for extracting the program information corresponding to the content data from the transport stream (display on the screen requested PPV program to user, as shown in Fig. 28 and 30); and

stopping means for stopping the receiving process of the receiving means in accordance with purchase limit time included in the program information(the PPV program ended at 10:00 o'clock for a duration of 2hrs, as indicated by el. 544 in Fig. 28), and wherein the purchase limit time is set based on the time it takes to download the content data.

Claim 7, Lajoie further discloses wherein the contents data includes audio data encoded in the ATRAC system or audio data encoded in the MPE-2 system (Col. 10, lines 29-40 and Col. 14, lines 1-40).

Claim 8 is analyzed with respect to claim 6.

Claim 26, Lajoie further discloses an encoder that formats a portion of the content data into encoded content data that is provided to the multiplexer and repeatedly transmitted (reads on the display message of el. 544 is inherently cyclically transmitted to users such PPV information/service along with updating information within that period of time; Col. 10, lines 25-55).

Claim 27, Lajoie discloses an apparatus for preparing content data that includes video data and audio data for transmittal as a broadcast signal, the apparatus comprising:

An encoder for encoding the audio data into at least one audio data packets (inherent for encoding MPEG packets; Col. 10, lines 29-40 and Col. 14, lines 1-40);

A generator for generating a control message, the control message including a purchase limit time that is associated with the time it takes to download the audio data (inherent ; on set time in which user could buy a PPV program, i.e., "Buy until 8:15 PM; Fig. 28, el. 544; Col. 31, lines 1-32);

and a multiplexer (Fig. 1, el. 17) for combining the at least one audio data packets with the control message to form the broadcast signal such that the at least one audio data packet is repetitively transmitted as part of the broadcast signal (reads on the display message of el. 544 along with audio is inherently cyclically transmitted to users such PPV information/service along with updating information within that period of time; Col. 10, lines 25-55).

Claim 28-29, Lajoie further discloses the encoder compress the audio data according to the MPEG-2 compression format in which the audio data is encoded by the ATRAC system or audio data encoded by the MPEG-2 system (Col. 10, lines 29-40 and Col. 14, lines 1-40).

Claim 30, Lajoie further discloses wherein the encoder encodes the audio data into one audio data packet that is repetitively transmitted as part of the broadcast signal (reads on the display message of el. 544 is inherently cyclically transmitted to users such PPV information/service along with audio and updating information within that period of time; Col. 10, lines 25-55).

Claim 31, Lajoie further discloses wherein the control message includes a preview time parameter (see Fig. 32, in which the user able preview within a preview window).

Claim 33, Lajoie further discloses an apparatus as discussed in claim 6 in which receiving program is descrambled (Col. 4, lines 47-50).

Claim 34 and 35 is analyzed with respect to 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2623

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 32 and 36 are rejected under 35 U.S.C. 103(a) as obvious over Lajoie et al. (US 5850218).

Claims 32 and 36, Lajoie does not disclose "a preview time parameter defines a limit for the number of times the audio data can be previewed" and "wherein if the control unit determines that the audio data cannot be downloaded with the purchase time limit, and indication is provided to the user that the purchase time has elapsed."

Official Notice is taken that using a counter for limiting the number of usage for purpose of controlling usage and providing a message to notify to user that the purchase time (number of time) limit has elapsed for the purpose of notifying message to user the reason why he/she could not allow to access is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lajoie to have an access control as a counter and having a message to notify user of condition access so to provide to user a friendly interactive interface.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
11/09/2006


HAITRAN
PRIMARY EXAMINER